

REMARKS

In light of the following remarks, reconsideration and allowance of the present application are respectfully requested. Claims 1-19 are pending. No new matter has been added.

Rejections under 35 U.S.C. § 101

Claims 7-10 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. More specifically, the Examiner alleges that “computer recording medium,” as recited in claims 7-10, embodies functional descriptive material. Accordingly, Applicants have adopted the Examiner’s suggested amendment by amending claims 7-10 to recite a “computer readable medium storing a computer program.”

Therefore, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 101.

Rejections under 35 U.S.C. § 112

Claims 1-19 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which Applicants regard as the invention. Applicants traverse this rejection for the following reasons.

1. Claims 1 and 16 stand rejected because the Examiner alleges that the recitations “in such a way,” “at least one partial projection functionalized” and “functionalizing the at least one optically emphasized partial projection” are unclear. Applicants have omitted “in such a way” from claim 1 and have amended claim 1 to

recite “the at least one functionalized partial projection.” Regarding the recitation of “functionalizing,” Applicants provide the following:

35 U.S.C. § 112, second paragraph, provides:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As stated in MPEP 2173.02:

Definiteness of claim language [is analyzed] in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

Furthermore, MPEP 2173.02 goes on to state the following:

In reviewing a claim for compliance with 35 U.S.C. §112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. §112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent.

The scope of claims 1-19 are clear to one of ordinary skill in the art. In an example embodiment of the present application, the visualization of hot spots is functionalized in such a way that the user can select one of the hot spots. Accordingly, claims 1-19 apprise “one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. § 112, second paragraph.”

2. Claims 1 and 16 also stand rejected as being incomplete for omitting essential steps. The Examiner asserts that “displacement of the user input or the like” is an essential step that is omitted because the claim suggests that there is a displacement.

The claim currently provides that the at least one projection is displaced, but does not recite that the user input is displaced. Moreover, Applicants have amended claim 1 to clarify claim 1.

Therefore, Applicants respectfully request that the current rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

Rejections under 35 U.S.C. § 103

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as being anticipated by Gering et al., *A System for Surgical Planning and Guidance using Image Fusion and Interventional MR*, hereinafter “Gering,” in view of Golland et al., *Anatomy Browser: A Novel Approach to Visualization and Integration of Medical Information*, hereinafter “Golland.” Applicants traverse this rejection.

Claim 1 requires, *inter alia*, “automatically displacing ... the at least one projection not including the at least one partial projection in such a way that it includes the partial projection.” At least this feature is not disclosed or suggested by Gering, Golland or a combination of the two (assuming they could be properly combined, which Applicants do not admit).¹

As admitted by the Examiner, “Gering fails to specifically teach automatically displacing as a function of the user input the at least one projection not including the at least one partial projection in such a way that it includes the partial projection.” Thus, the Examiner relies on Golland to teach this feature.

Golland discloses an anatomy browser which provides cross-referencing among types of displays. “If a user clicks on one of the display areas (<Shift-Click>), a cross-

¹ To be thorough, further expedite prosecution, and for the sake of clarity, Applicants provide discussions of each of the references separately, however, Applicants are not attacking these references individually, but arguing that the references, even taken in combination, fail to

hair appears on all four displays at locations corresponding to the same 3D point." See, 4.2 of Golland. Thus, if an input is made for a first display, the other displays are not changed. Accordingly, the anatomy brower of Golland does not automatically displace "at least one projection not including the at least one partial projection in such a way that it includes the partial projection," as required by claim 1. By contrast, the displays are not displaced in Golland when the anatomy browser receives a user input.

Therefore, Gering and Golland fail to render claim 1 obvious. Claims 2-15, which are dependent on claim 1, are patentable for at least the reasons set forth above regarding claim 1.

Claim 16 is a separate independent claim from claim 1, wherein each independent claim contains its own individual limitations. Claim 16 should be interpreted solely based upon limitations set forth therein. However, claim 16 is patentable for at least reasons somewhat similar to those set forth above regarding claim 1. Claims 17-19, which are dependent on claim 16, are patentable for at least the reasons set forth above.

For at least the foregoing reasons, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-19 under 35 U.S.C. § 103.

render the claimed invention obvious because all features of claim 1 are not found in the prior art.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 1-19 in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Donald J. Daley at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. §1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By


Donald J. Daley, Reg. No. 34,313

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

DJD/BMH/akp
BMH